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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,328	02/24/2004	Cesar A. Galindo-Legaria	MSFT-3515 (138320.02)	9709

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EXAMINER

VEILLARD, JACQUES

ART UNIT PAPER NUMBER

2165

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,328

Applicant(s)

NAGASAWA ET AL.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-36, 38 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-36 and 38 is/are allowed.
- 6) ☒ Claim(s) 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Applicant's communication filed on 3/21/2005.
2. Claims 1-32, 37, and 39 have been canceled.
3. Claims 33-36, and 40-43 are pending and are presented for examination.

Response to Applicant's Remarks

4. Applicant's request filed on March 21, 2005 for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. A rejection based on a double patenting follows.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 40-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-27 of U.S. Patent No. 6,721,724.

Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the claims are arguably broader than claims 24-27 of Galindo-Legarria et al. '724 which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See In re Karlson, 136 USPQ 184.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent.

This is an obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As per claim 40, A method for generating a plan for executing a database query, the method comprising the steps of: arranging a plurality of execution plans into a plurality of groups, each group having at least one operator associated with at least one operator in another of the groups; determining identification data for each operator related to other operators in the other of the groups; and determining identification data for each execution plan based on the identification data for each operator, whereby the identification data for each execution plan uniquely identifies the respective execution plan from all other execution plans (See claim 24 of patent 6,721,724). The only difference between the claimed method of the pending application and the method in the patent is that the claim language at the preamble has slightly changed. For example (patent

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'724) recites at the preamble "A method for validating alternative ...". In light of the above, it is clear that the claims in the application and the patent 6,721,724 are basically the same.

As per claim 41, The method of claim 40, wherein the identification data for each execution plan represents a combination of operator choices within the groups used to obtain the respective execution plan (See claim 25 of patent 6,721,724). It is clear that claim 41 in the application and claim 25 of patent 6,721,724 are basically the same.

As per claim 42, The method of claim 40, wherein the rank data for the execution plans is represented by consecutive designations, whereby a valid execution plan can be generated for any designation selected at random, and that different designations produce different execution plans (See claim 26 of patent 6,721,724). It is clear that claim 42 in the application and claim 26 of patent 6,721,724 are basically the same.

As per claim 43, A method for generating a plan for executing a database query, the method comprising the steps of: developing groups of operators representing alternative execution plans for a query; ranking the operators; assigning identifiers to the alternative execution plans based on the ranking of the operators assembling an execution tree for a selected execution plan by unranking the selected execution plan, wherein unranking the selected execution plan involves selecting one of the operators from each group associated with the identifier of the selected execution plan (See claim 27 of patent 6,721,724). The only difference between the claimed method of the pending application and the method in the patent is that the

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claim language at the preamble has slightly changed. For example (patent '724) recites at the preamble "A method for validating alternative ...". In light of the above, it is clear that the claims in the application and the patent 6,721,724 are basically the same.

Allowable Subject Matter

7. Claims 33-36, and 38 are allowed over the prior of record as previously indicated.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art taken singularly or in combination fail to teach or suggest a system comprising a ranking module for ranking the operators in groups and unranking the operators so as to construct a plurality of different execution plans for a query, wherein each execution plan is assigned a unique global rank, based on operator rank data, that identifies one respective execution plan from all other possible execution plans as recited in independent claim 33.

The dependent claims 34-36, and 38, being further limiting to the independent claim 33, definite and enabled by the specification are also allowed.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 Am to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272- 4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles Rones
CHARLES RONES
PRIMARY EXAMINER

J.V.
Jacques Veillard
Patent Examiner TC 2100

April 11, 2005